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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,439	09/26/2003	Rami Caspi	2003P08209US	8507

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Siemens Corporation
Attn: Elsa Keller, Legal Administrator
Intellectual Property Department
170 Wood Avenue South
Iselin, NJ 08830

EXAMINER

ISSING, GREGORY C

ART UNIT	PAPER NUMBER
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3662

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/672,439

Applicant(s)

CASPI ET AL.

Examiner

Gregory C. Issing

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The disclosure is objected to because of the following informalities: on page 1 of the specification, the numerous related application information is incomplete and is required to be updated. Applicants have had ample time to update the specification with respect to the related pending applications and have failed to do so. Applicants are reminded of their responsibility to update the specification as soon as reasonably expected.

Appropriate correction is required.

Though the applicants amended the claims with respect to the language "out of a range" but the specification remains unchanged and thus unclear.

2. The applicants are reminded to maintain a clear line of distinction between the present application's claims and claims of related applications, particularly, applications 10/672,364, 10/672,377, and 10/672,456.

3. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the language "determined to be *out of* a predetermined location" fails to clearly and distinctly set forth the subject matter; the terminology "outside of" is suggested. In claim 1, lines 7-10, fail to clearly and distinctly set forth the subject matter. The claim is directed to a "telecommunication device," thus, limitations of a separate element, i.e. an administration device, do not provide any further limitation to the telecommunication device. Furthermore, the scope of the limitation regarding the administration device is not understood; does the administration device only "maintain" an availability rule of a user when "it" – does this refer to the administration device or user or telecommunication device - is at a predetermined location? The positioning information is only transmitted to the administration device when it is outside of a predetermined location, thus how does the administration device associate an availability rule for use when the telecommunication device is not outside of the predetermined location? The scope of the

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amendment regarding the administration device is not ascertainable and it is not clear if this would read on the conventional cellular base station which registers mobile cell phones when the respective cell phones are within its cell, i.e. the cell base station registers the cell user to its zone thus alerting the network of the availability of a particular cell phone therein.

Claim 2 is indefinite due to its dependence on claim 9 which appears to be a typographical error in the amendment since it originally was indicated as dependent on claim 1.

In claim 5, the language "out of a predetermined location" is again not clear.

In claim 7, there is an inconsistency in the language with respect to "an administrative device" and "said administration device". The second use lacks a proper antecedent basis. Lines 8-10 fail to clearly and distinctly set forth the subject matter for reasons previously set forth above.

In claim 12, lines 6-8 fail to clearly and distinctly set forth the subject matter for reasons previously set forth above. It is further not clear what limitation to a method the added language provides. There is an inconsistency in the language with respect to "an administrative device" and "said administration device". The second use lacks a proper antecedent basis.

In claim 17, the subject matter is directed to a computer with a graphical user interface and a controller. It is not clear if this appears to describe the computer for the wireless communication device or the administrative device. Either way, it cannot provide limitations to both since the disclosure fails to provide single computer that provides all of the alleged limitations for selecting locations, programming the location therein, receiving positioning signals, transmitting positions, transmitting alerts, and maintaining availability rules. Thus, it is unclear how the computer includes limitations to a separate and distinct wireless communication device and an administrative device. Claim 19 further falls within the in clarity.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Yoakum et al (6,658,095).

Yoakum et al disclose a system and method for maintenance of availability rules for subscribers in the telecommunications industry. The availability rules may combine information about the location and activities of subscribers (see col. 5, e.g.). Moreover, a presence information that maintains the information is automatically updated for each presence category, if necessary, when state changes are detected. Depending on the presence rules, a state change from a given device may or may not impact the presence information. If the presence information does not change, then there might not be a need to update the subscribing presence applications (see par. bridging cols. 8 and 9). Thus, upon a change in state, which states may include position, the user alerts the presence system of a change in position.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elliot in view of Teckchandani et al.

8. Elliot discloses a locator system as set forth in the previous Office Action including a wireless user device 12 capable of determining position using GPS signals (from 14) or cellular base

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stations signals (from 15) wherein the wireless user device also includes a wireless communication device communicating with a central TR 16 using analog or digital cellular, PCS, or paging for subsequent communication with central control system 20. The central control system 20 further includes (1) a database maintaining availability rules associated with the wireless user device including threshold criteria for the alert and auto-notification process. The threshold criteria are customer selectable/updatable (col. 8, par. 2 and 4) while the database also includes the auto-notification process including selection of a page, telephone call, or e-mail (col. 8, par. 2) for providing the auto-notification message to the customer.

9. In Elliot, the determination of exceeding threshold criteria appears to be in the administration device as opposed to the wireless user device. However, Elliot does provide the teachings, in the environment of a locating system in a telecommunications system of sending an alerting/notifying message when a mobile wireless device exceeds customer-selectable, threshold criteria as well as a database, i.e. customer profile, for maintaining availability rules for users of the telecommunication network wherein availability rules associates the type of communication to be used in the alerting/notifying step. Additionally, the threshold criteria may associate a predetermined location with a range of motion/time ("predefined units of distance in the past hour"). Graphical interfaces are provided at both the central control station as well as the customer device.

10. Teckchandani et al teach a wireless, mobile asset 103 having a positioning receiver 229 for determining position, a wireless communication device 223 for receiving positioning info from a controller 201 controlling the positioning and communication devices and causing the position info to be transmitted to an associated administration device in the form of user device 107 when detection of a violation is processed, such as outside permitted locations of interest specified by the user. It is not clear if Teckchandani et al differ from the claimed subject matter with respect to the limitation of "availability rules . . . associated with a user." Since the language of the claims fails to clearly and distinctly set forth with any degree of definiteness what this language means, it can be

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interpreted as storing and maintaining in a database, profile information about the user, such as a history of location tracks in a predetermined building.

11. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Elliot by incorporating the threshold detections in the mobile asset as shown by the conventionality of such alternative as suggested by Techchandani et al to enable the monitoring of the mobile asset:

12. Claims 1-19 are under 35 U.S.C. 103(a) as being unpatentable over Wilson et al (US2004/0203903).

13. Wilson et al relate to a location-based services in a system for providing wireless telecommunications services to mobile devices. Wilson et al describe the capability of a user to establish invisibility options with respect to geographical criteria [0160] and time criteria [0158] such that the portal associates availability of the user of the telecommunications device on the basis of location. Moreover, the telecommunications device may be integrated with a GPS or other location chipset or receiver [0164] such that the telecommunications device transmits the position information to the portal with or without a query. Wilson et al differ from the claimed subject matter since the telecommunications controller is not identified as providing transmission of the location information upon the condition that the position of the telecommunication device is outside a predetermined location. However, in view of the fact that the various positional criteria suggested includes setting a range (radius) from a predetermined location (metropolitan area), or within a radius surrounding a zip code, or a particular city limit, it is clear that the telecommunication device does send the location information without query; thus, several alternatives exist – automatically based on time (interval), automatically based on position, automatically based on movement (distance change), or manually by the user. As it would appear probable that automatically based on time would be linked to the establishment of invisibility options with respect to certain schedules, it would appear equally probable that the establishment of invisibility options with

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respect to geographical criteria would be linked to automatically transmitting on the basis of the geographical criteria, i.e. outside a predetermined radius of a predetermined area, inside a predetermined radius of a predetermined ZIP code, or inside/outside a particular city. The selection of transmitting position without query upon sensing boundary crossings, i.e. outside a predetermined location, would have been obvious to the skilled artisan at the time the invention was made since it would necessarily reduce the amount of communication to the portal for updating changes in positional criteria since the transmission of position would be indicative of turning on or off the invisibility condition. Wilson et al show the use of GPS, cellular telephones, maintenance of availability rules, association of presence and time in the availability rules, and user interfaces for user control of availability rule.

14. Applicants argue that the prior art fail to show rules for contacting a user that are associated with the user's location; it is not clear how the claim limitations define this feature. Thus, it appears that the applicants' do not argue claim limitations therewith. Applicants argue that the prior art fail to suggest an administration device that is configured to maintain availability rules associated with a user based on whether it is determined to be in the predetermined location. As stated above, this language fails to clearly and distinctly set forth the subject matter so as provide a clear line of demarcation with respect to the scope of the limitation. Furthermore, the maintenance of availability rules at an administration device is seen to be known in the art as suggested by the various references set forth above, i.e. the storage of profiles associated with a user to indicate information about the user, what form of communication to use, or what thresholds to utilize are shown by the prior art. Thus, the applicants' arguments are not convincing.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Zhou et al (6,847,892) disclose the conventionality of the convergence of wireless positioning, wireless telecommunications, and sensor technology in the field of asset tracking. The wireless positioning is envisioned as using GPS and/or radio frequency triangulation. The wireless

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telecommunications in envisioned as any of the well-known and conventional communications technologies (col. 3, line 66 – col. 4, line 8). Thresholds for providing alerts are controllable by a user and may include a radius around a given address (col. 16, par. 1). Rignell et al (US2001/0024951) disclose the conventionality and desire of a mobile telecommunications device receiving availability status information regarding other telecommunications devices via the telecommunications network or directly from other telecommunications devices. Regarding the status from the telecommunications network, a network facility maintains availability rules for each of the subscriber devices and provides such automatically or upon request wherein home devices are stored in a home database 19 and foreign subscribers are stored in a visitor database 20. Horvitz et al (6,745,193) disclose a method and system for managing and directing electronic information transfers such as when and how to notify/alert a message recipient including maintaining rules for subscribers including information about people, their presence, their availability for communication, and their type of communication (see col. 1 and 8, e.g.).

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory C. Issing whose telephone number is (571)-272-6973. The examiner can normally be reached on Monday - Thursday 6:00 AM- 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza can be reached on (571)-272-6979. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gregory C. Issing
Primary Examiner
Art Unit 3662

gci